

Appln. No. 10/722,920
Amdt. dated August 17, 2005
Response to Office Action of May 17, 2005

Docket No. 98005.00012

REMARKS

Claim Disposition

Claims 1 – 34 and 40 – 42 are pending in this application. Claims 1 – 34 and 40 – 42 have been rejected. Claims 41 and 42 have been amended to further clarify that which the Applicant considers his invention.

Claim Rejections 35 U.S.C. 102

Claims 1 - 3 and 11 stand rejected under 35 U.S.C. 102 (b) as being anticipated by Michelson U.S. Patent No. 4,985,019, hereinafter referred to as Michelson. Applicant respectfully traverses. The Examiner in rejecting the claims states:

“With respect to claim 1, Michelson discloses a marker comprising a substrate (10) having at least one portion with an adhesive backing (30) and further having at least one portion having indicia (See Figure 2) for identifying or measuring details of an area on which the marker is to be overlaid.”

“In regards to claim 2, Michelson teaches a marker wherein the substrate comprises a first portion and a second portion, the first portion having a surface with an adhesive backing (30), the second portion (14) having the indicia for identifying or measuring details of a surface.”

“Regarding to claim 3, Michelson further shows a marker wherein the indicia comprises a target sight (See Figure 2).”

“In regards to claim 11, Michelson further teaches a marker wherein the target sight comprises at least two orthogonal line segments (See Figure 2).”

Applicant respectfully contends that the explanation in the Office Action mischaracterizes the teachings of Michelson. To anticipate a claim under 35 U.S.C. §102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barent, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements “**arranged as in the claim.**” (emphasis added) *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Moreover, “[t]he identical invention must be

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shown in as complete detail as is contained in the ...claim."(emphasis added) *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

With regard to Claim 1 in particular, Applicant respectfully contends that Michelson does not teach or disclose each element of the invention "arranged as in the claim". Specifically, Michelson does not teach or disclose, "a substrate ... having at least one portion that is substantially transparent". Moreover, Michelson does not teach or disclose that the marker "has indicia for identifying or measuring details of an image on which the marker is to be overlaid." Michelson specifically teaches a marker directed not to marking an image but a patient. More particularly, Michelson teaches a marker with a hole therein to guide a needle. The claimed invention includes no such constraint. Therefore, because Michelson does not disclose or teach an element of the invention it cannot anticipate the Applicant's claims. Thus, Claim 1 is allowable, the rejection is improper, and should be withdrawn.

In view of the above discussion, Claims 2, 3, and 11 depend from Claim 1 whether directly or indirectly, and include all of the corresponding limitations thereof. Claim 1 is not taught by Michelson, therefore, Claims 2, 3, and 11 cannot be taught by Michelson either. Thus, Claims 2, 3, and 11 are allowable, the rejections are improper and they should be withdrawn.

Claims 29 - 33 stand rejected under 35 U.S.C. 102 (b) as being anticipated by Smolen, U.S. Patent No. 4,015,034, hereinafter referred to as Smolen. Applicant respectfully traverses. The Examiner in rejecting the claims states:

"In regards to claim 29, Smolen discloses an apparatus comprising a light transmitting substrate for providing an image, i.e., register sheets; a removable marker (10) having a first portion with adhesive backing (12) for attachment to the light transmitting substrate and further having a second portion (S, S') that is substantially transparent and without adhesive backing thereby allowing the second portion to be lifted from the light transmitting substrate, without the need to lift the adhesive backed portion. Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed

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apparatus from a prior art apparatus satisfying the claimed structural limitations. *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)."

"Regarding claims 30 and 31, Smolen teaches the image being a diagnostic image and wherein the light transmitting substrate is an x-ray film."

"With respect to claim 32, Smolen teaches an apparatus comprising a light transmitting substrate, i.e., register sheets; and a removable marker (10) having a first portion with adhesive backing (12) for attachment to the light transmitting substrate and further having a second portion (S, S') that is substantially transparent and has a target sight (15) inscribed thereon."

"Regarding claim 33, Smolen discloses an apparatus comprising a light transmitting substrate, i.e., register sheet; and a removable marker (10) having a first portion with adhesive backing (12) for attachment to the light transmitting substrate and further having a second portion (S, S') that is substantially transparent, wherein at least one of the first portion and the second portion includes a gauge portion defined by a target area (15)."

Applicant respectfully contends that the explanation in the Office Action mischaracterizes the teachings of Smolen. With regard to Claims 29, 32, and 33 in particular, Applicant respectfully contends that Smolen does not teach or disclose each element of the invention "arranged as in the claim". Specifically, Smolen does not teach or disclose, "a second portion that is substantially transparent and without adhesive backing thereby allowing the second portion to be lifted from the light transmitting substrate, without the need to lift the adhesive backed portion". No part of the *marker* as disclosed in Smolen is substantially transparent. Smolen instead teaches placing two corresponding indicia on transparent media (S, S') so that, in essence, one may readily observe when layers, that is, S, S' once overlain are properly registered. The claimed invention includes no such constraints. Applicant further directs the Examiner's attention to note that the rejection relies on transparency layers S, S' as portions of the marker. However, it is evident from the teaching of Smolen that these elements are not at all part of the marker as taught therein, but instead the media that the marker is applied to. Therefore, because Smolen does not disclose or teach an element of the invention it cannot anticipate the Applicant's claims. Thus, claims 29, 32, and 33 are allowable, the rejections are improper, and should be withdrawn.

In view of the above discussion, claims 30 and 31 depend from claim 29 whether directly or indirectly, and include all of the corresponding limitations thereof. Claim 29 is not taught by

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Smolen, therefore, claims 30, 31, cannot be taught by Smolen either. Thus, claims 30 and 31, are allowable, the rejections are improper and they should be withdrawn.

Furthermore, with respect to claims 30 and 31, Applicants respectfully disagree with the Examiner's assertions. Applicants find no teaching whatsoever in Smolen of the elements of the claims. In particular, "wherein the image is a diagnostic image" or "wherein the light transmitting substrate is an x-ray film"

Claims 34 and 41 - 42 stand rejected under 35 U.S.C. 102 (b) as being anticipated by U.S. Patent No.4,951,595 to Bedford Jr., hereinafter referred to as Bedford Jr. Applicant respectfully traverses. The Examiner in rejecting the claims states:

"With respect to claim 34, Bedford Jr. discloses an apparatus comprising a light transmitting substrate, i.e., X-ray, for providing an image; and a removable marker (10) having a first portion with adhesive backing (11) for attachment to the light transmitting substrate and further having a second portion (13) that is substantially transparent and includes a surface (13) that could receive writing, if so desired by the user."

"Regarding claim 41, Bedford Jr. teaches a method for marking an area of interest on a diagnostic image comprising the steps of providing a diagnostic image, i.e., X-ray, and marking an area of interest on the diagnostic image using a marker (See Column 2, lines 44 - 45) comprising a substrate (10) having a first portion and a second portion, wherein the first portion has a surface (11) with an adhesive backing (14) and the second portion is substantially transparent and has indicia (arrow 13, or hand writing if desired by the user) for identifying the area of interest on the diagnostic image."

"In regards to claim 42, Bedford Jr. further discloses a marker comprising a substrate having a first portion and a second portion, wherein the first portion has means (11) for releasably adhering the substrate to a diagnostic image, i.e., X-ray, and the second portion has means (indicia) for identifying an area of interest on the diagnostic image."

Applicant, once again, respectfully contends that the explanation in the Office Action mischaracterizes the teachings of Bedford Jr. With regard to Claim 34 in particular, Applicant respectfully contends that Bedford Jr. does not teach or disclose each element of the invention "arranged as in the claim". Specifically, Bedford Jr. does not teach or disclose, "wherein the first portion includes a paper surface for receiving writing". No part of the marker as disclosed in Bedford Jr. includes a paper surface for receiving writing. Therefore, because Bedford Jr. does not disclose or teach an element of the invention it cannot anticipate the Applicant's claims.

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Thus, claim 34 is allowable, the rejection is improper, and should be withdrawn.

Claims 41 and 42 have been amended to further clarify that which the Applicant considers his invention. Furthermore with respect to Claims 41 and 42 as amended, Applicant respectfully contends that Bedford Jr. does not teach or disclose each element of the invention "arranged as in the claim". Specifically, Bedford Jr. does not teach or disclose, "wherein the first portion **includes a paper surface for receiving writing**". No part of the marker as disclosed in Bedford Jr. includes a paper surface for receiving writing. Therefore, because Bedford Jr. does not disclose or teach an element of the invention it cannot anticipate the Applicant's claims. Thus, claim 41 and 42 should now be considered allowable.

Claims 1 and 40 is rejected under 35 U.S.C. 102 (b) as being anticipated by U.S. Patent No. 6,063,225 to Riordan, hereinafter referred to as Riordan. Applicant respectfully traverses. The Examiner in rejecting the claims states:

With respect to claim 1, Riordan discloses a marker comprising a substrate (41) having at least one portion with an adhesive backing (40a) and further having at least one portion (34) that is substantially transparent and has indicia (See Figure 5) for identifying or measuring details of an image on which the marker is to be overlayed.

In regards to claim 40, Riordan also discloses an apparatus comprising a holder (50); and a plurality of markers releasably mounted in the holder (See Column 4, lines 21 - 34).

Applicant respectfully contends that the explanation in the Office Action mischaracterizes the teachings of Riordan. With regard to Claims 1 and 40 in particular, Applicant respectfully contends that Riordan does not teach or disclose each element of the invention "arranged as in the claim". Specifically, Riordan does not teach or disclose, "**has indicia for identifying or measuring details of an image**". No part of the tape as disclosed in Riordan includes indicia for identifying or measuring. In fact, Riordan includes no teaching whatsoever regarding the tape including indica. While Riordan may include disclosure regarding the tape including a means for receiving written indicia as suggested by the Examiner, this is not at all equivalent to one portion of the marker including indicia for identifying or measuring details of an image as claimed. Therefore, because Riordan does not disclose or teach an

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element of the invention it cannot anticipate the Applicant's claims. Thus, claims 1 and 40 are allowable, the rejections are improper, and should be withdrawn.

Claim Rejections 35 U.S.C. 103

Claim 13 stands rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,985,019 to Michelson, hereinafter referred to as Michelson. Applicant respectfully traverses. The Examiner in rejecting the claims states:

"Michelson discloses a marker as stated in paragraph 2 above."

"Michelson does not disclose the squares having a dimension of 1 cm as stated in claim 13."

"With respect to claim 13, Michelson discloses a marker wherein the target sight comprises a grid pattern having a plurality of squares having side dimensions of about 2 - 3 mm (See Column 1, line 68). To make a square having a diameter of 1 cm, is only considered to be the " optimum " value of the diameter for the square, as stated above, that a person having ordinary skill in the art at the time the invention was made would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide a square having a diameter of 1 cm in order to provide enhance the visibility of the target different color surfaces or different light intensity."

Applicant respectfully contends that the Examiner has mischaracterized Applicant's invention or the cited art and has improperly rejected the claims under Section 103. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596,

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1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Applicant respectfully contends that Michelson does teach or disclose each element of the invention. In particular, Michelson does not teach or disclose several elements of claim 1 as cited above. Claim 13 depends from claim 1, whether directly or indirectly and includes all of the corresponding limitations thereof. Claim 1 is not taught by Michelson, therefore, claim 13, cannot be taught by Michelson either. Thus, claim 13 is allowable, the rejection is improper and it should be withdrawn.

Claims 1 - 7, 11, 12, and 14 - 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0182815 to Carlson II, hereinafter referred to as Carlson. Applicant respectfully traverses. The Examiner in rejecting the claims states:

"With respect to claim 1, Carlson discloses a marker comprising a substrate (10) having at least one portion with an adhesive backing (16) and further having at least one portion that is substantially transparent and has indicia (See Figure 2) for identifying or measuring details of an area on which the marker is to be overlaid."

"In regards to claim 2, Carlson teaches a marker wherein the substrate comprises a first portion and a second portion, the first portion having a surface with an adhesive backing (16), the second portion (14) having the indicia for identifying or measuring details of a surface."

"Regarding to claim 3, Carlson further shows a marker wherein the indicia comprises a target sight (See Figure 2)."

"With regards to claim 4, Carlson discloses a marker wherein the target sight substantially defines a perimeter around a region of the second portion."

"In regards to claim 5, Carlson also teaches a marker wherein the target sight focuses a reader's attention on a region of the image. However, the claimed limitation of claim 5, fails to further limit the subject matter, since it merely recites a functional statement and does not defines a particular feature or structure."

"Regarding claim 6, Carlson shows a marker wherein the target sight substantially surrounds a region of the second portion."

"With respect to claim 7, Carlson teaches a marker wherein the target sight comprises at least one circle."

"In regards to claim 11, Carlson further teaches a marker wherein the target sight comprises at least two orthogonal line segments (See Figure 2)."

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"Regarding claim 15, Carlson also shows a marker wherein the second portion has a substantially adhesive free backing (free of any adhesive)."

"Regarding claims 16 - 21 and 27, Carlson also shows a marker comprising a note portion (26) that is not transparent; wherein the note portion comprises a surface adapted to receive ink writing; wherein the note portion also includes a plurality of substantially parallel lines (See Figure 2); said note portion overlays the first portion and the note portion comprises a paper surface to receive writing."

"In regards to claim 28, Carlson also discloses a releasable sheet (18) disposed on the adhesive backing."

"Carlson does not disclose the substantially transparent portion as stated in claims 1. Carlson does not disclose the particular diameter for the target circle as stated in claims 8 - 10. Carlson does not disclose the square as stated in claim 12 and the line segments disposed on one or more lines bisecting the circle as stated in claim 14. Carlson does not disclose the specific indicia as stated in claims 22 - 26."

"In regards to claim 1, Carlson discloses a marker made of incise material, but does not specifies transparency characteristics. The particular type of material used to make the marker, absent any criticality, is only considered to be the use of a " preferred " or " optimum " material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant's apparatus, i.e., suitability for the intended use of Applicant's apparatus. See In re Leshin, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide a transparent portion on said marker in order to increase the accuracy of the marking by increasing the contrast between the indicia and the surface to be marked."

"With respect to claims 8 - 10, Carlson discloses a marker having a target comprising at least one circle but fails to disclose the particular diameter. To make a circle having a diameter of 1, 2, and/or 4 inches, is only considered to be the " optimum " value of the diameter for the circle, as stated above, that a person having ordinary skill in the art at the time the invention was made would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See In re Boesch, 205 USPQ 215 (CCPA 1980). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide a circle having a 1 inch, 2 inches or 4 inches diameter in order to provide a visible target that's easy to read and localize on different color surfaces or different light intensity."

"In regards to claims 12 and 14, Carlson discloses a marker having a target defining a circle. The use of a square on the target, absent any criticality, is only considered to be obvious modifications of the shape or configuration of the target shape disclosed by Carlson as the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by

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Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide using routine experimentation based on its suitability for the intended use of the invention. See *In re Dailey*, 149 USPQ 47 (CCPA 1976)."

"Regarding claims 22 – 26, Carlson discloses a marker having indicia inscribed on said marker. However, the claims neither define new features of structure nor new relations of printed matter to structure. The printed matter defined does not distinguish over the cited art, i.e., Carlson, in terms of patentability. In the present case, with respect to the reference markings comprising inscribed dimensions or graduations, the only functional relationship between the printed matter and the apparatus is that the reference markings are provided on at least a first side and a second side of the apparatus. However, there is nothing new and unobvious in the type of reference markings as demonstrated by Carlson. Mere claim of the type of reference markings provided on the apparatus are not the kind of "new and unobvious functional relationship " necessary for giving the printed matter patentable weight. See *In re Gulack*, supra, and *In re Miller*, 164 USPQ 46 (CCPA 1969)."

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Applicants respectfully contend that Carlson does not teach or disclose each element of the invention. In particular, Carlson does not teach or disclose a substrate having at least one portion that ... "has indicia for identifying or measuring details of an image on which the marker is to be overlaid. To support the rejection, the Examiner has cited the marker of Carlson which is directed to marking a surgical site on a patient. Carlson is not at all directed to marking an image as the Applicant has claimed. Therefore, because Carlson does not disclose or teach an element of the claimed invention it cannot render the Applicant's claims unpatentable. Thus,

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claim 1 is allowable, the rejection is improper, and should be withdrawn.

In view of the above discussion, claims 2 – 7, 11-12, and 14 – 28 depend from claim 1 whether directly or indirectly, and include all of the corresponding limitations thereof. Claim 1 is not taught by Carlson, therefore, claims – 7, 11-12, and 14 – 28 cannot be taught by Carlson either. Thus, claims – 7, 11-12, and 14 – 28, are allowable, the rejections are improper and they should be withdrawn.

Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned. If the Examiner has any questions in connection with this paper, or otherwise if it would facilitate the examination of this application, please call the undersigned at the telephone number below.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicant's attorney hereby authorizes that such fee be charged to Deposit Account No. 50-3569.

Respectfully submitted,

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